

Applicants believe that no new matter has been introduced by the amendment and no additional fees are required for the application.

#### 112 Rejections

The claims were amended to correct for any 112 ambiguities, and for stylistic reasons.

#### 102 Rejections

A number of claims were rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent 5,737,054, by Chao (the "Chao Patent").

The present application is a continuation-in-part of the Chao Patent, as indicated by the first paragraph of the specification with the application having the serial number 08/766,327. Also, the Chao Patent was not published until April 7, 1998, which is after the filing date of the present application. Thus, the Chao Patent is not available as a 102(b) prior art against the present application.

#### 103 Rejections

A number of claims were rejected under 35 U.S.C. 103 as being unpatentable over the Chao Patent alone, or over the Chao Patent in view of U.S. Patent 5,642,177, by Nishioka. Again, as explained above, the Chao Patent is not available as a prior art reference against the present application.

## Obviousness Double Patenting Rejections

The application was rejected based on a number of obviousness double patenting rejections. There are a number of reasons why the rejections are not applicable. One of them is that the claims remaining in the application are patentably distinct from all of the cited applications, as shown by the following discussion.

### I. The Application With Application No. 08/848,129

Th 08/848,129 application describes extensions at arms with clamps at the end of arms going down from the side. The present application is specifically on coupling mechanisms away from the temples of frames, as explained, for example, on line 11, page 2 to line 5, page 3 of the specification, reproduced below:

One reason for the magnets to be close to the temples is that the pair of magnets on a frame should be as far apart as possible. This is to ensure the auxiliary frame to be right over the primary frame, not only at the locations close to the bridges of the frames, but also at the locations close to the arms of the frames. However, in order to have sufficient coupling power, the magnets on the auxiliary frame have to match in both locations and orientations to the magnets on the primary frame. This is not an easy task, especially because the magnets are typically very small for stylistic reasons.

The further away the pair of magnets are on a frame, the more difficult it is to align them in both locations and orientations to magnets on another frame. First, imagine the

magnets in a primary frame are slightly off in locations from those in an auxiliary frame. Since the magnets are quite small, slight misalignment in the locations would significantly reduce magnetic coupling between the frames. Next, imagine one small magnet in the primary frame is different in orientation from its corresponding magnet in the auxiliary frame. This can happen, for example, if the auxiliary frame has been slightly twisted--the magnitude of the difference is proportional to the distance between the pair of magnets on the frame. Two magnets may not even be able to couple together if they have different orientations. Misalignment in locations or orientations not only adversely affects the coupling power of the auxiliary frame to the primary frame, but also creates an unpleasant outward appearance for the wearer, especially when the auxiliary frame is tilted relative to the primary frame.

Thus, the present invention specifically limits its coupling mechanisms away from the temples of the frames, and cannot be obvious over the application number 08/848,129.

## II. The Application With Application No. 08/847,708

The 08/847,708 application describes hooking mechanisms onto openings in spectacle frames. Just in case there might be any possibility of obviousness, Applicants have deleted all of claims with cavities for coupling, namely claims 4, 6, 7, 21, 23-25, 31, 32, 38 and 39. All

of the other remaining claims do not recite hooking mechanisms onto openings in spectacle frames, and cannot be obvious over the application number 08/847,708.

III. The Application With Application No. 08/847,707

The 08/847,707 application describes arms and ears with magnets attaching on the inside of frames. Again as explained in Section I, the present invention specifically limits its coupling mechanisms away from the temples of the frames, and cannot be obvious over the application number 08/847,707.

IV. The Application With Application No. 08/847,710

The 08/847,710 application describes magnets at rim locks of frames. Again as explained in Section I, the present invention specifically limits its coupling mechanisms away from the temples of the frames, and cannot be obvious over the application number 08/847,710.

V. The Application With Application No. 08/848,101

The 08/848,101 application describes clamps at temples of frames. Again as explained in Section I, the present invention specifically limits its coupling mechanisms away from the temples of the frames, and cannot be obvious over the application number 08/848,101.

VI. The Application With Application No. 08/847,709

The 08/847,709 application describes arms and flags, with magnets on the outside of frames. Again as explained in Section I, the present invention specifically limits its coupling

mechanisms away from the temples of the frames, and cannot be obvious over the application number 08/847,709.

VII. The Application With Application No. 08/847,711

The present application is a continuation-in-part application of the 08/847,711 application. Also, in 08/847,711, the auxiliary frame includes a portion, which can be a bridge. The portion has an extension extended rearward toward the primary frame. The extension has a flange, which extends downwards. A magnetic member at the flange is magnetically coupled to another magnetic member of the primary frame. In the present invention, magnetic members are not at a downward flange connected to an extension extended from a bridge, but are coupled to the bridge. Thus, the present invention cannot be obvious over the application number 08/847,711.

The remaining reference cited by the Examiners has been carefully considered. However, since it has not been applied against any of the claims and does not appear properly applicable thereto, no further mention thereof will be made.


In view of the above amendments and remarks, favorable reconsideration is respectfully requested and an early notice of allowance is earnestly solicited.

In the event that the Examiner, upon reexamination, determines that an action other than an allowance is appropriate, the Examiner is requested and authorized to telephone Applicant's attorney prior to taking such action, if the Examiner feels that such a telephone call will advance the prosecution of the present application.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 12/14/98

By:   
Peter P. Tong  
Reg. No. 35,757

FLIESLER, DUBB, MEYER & LOVEJOY LLP  
Four Embarcadero Center, Suite 400  
San Francisco, California 94111-4156  
Telephone: (415) 362-3800